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**DEC 13 2012**

**OFFICE OF PETITIONS**

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In re Patent No. 6,128,795 :  
Issue Date: 10/10/2000 :  
Application Number: 09/414,415 : ON PETITION  
Filing Date: 10/07/1999 :  
Attorney Docket Number: :  
50027.0008 :

This is a decision in reference to the petition under 37 CFR 1.378(b) filed on November 10, 2012.

The petition under 37 CFR 1.378(b) is dismissed.

The patent issued on December 10, 2000. The first and second maintenance fees were timely paid. The third maintenance fee could have been paid from October 10, 2011 through April 10, 2012, or, with a surcharge, from April 11 through October 10, 2012. The patent expired at midnight on October 10, 2012, for failure to timely pay the third maintenance fee.

On November 13, 2012, the subject petition was filed.

Petitioners' counsel, registered patent practitioner Lee G. Meyer, asserts that counsel reminded patentee's representative, Michelle Mariani, on several occasions that the maintenance fee was due. Prior to the expiration of the period for payment of the maintenance fee, patentee initially stated that she would pay the maintenance fee herself, then stated, in an email, that she had decided not to pay the maintenance fee. Patentee subsequently sent counsel, on July 13, 2012, also before the date the maintenance fee was due, a list of, *inter alia*, patents which patentee intended to abandon. The subject patent, however, was not on that list. Counsel states that two additional docket reports showing, *inter alia*, the due date for the third

maintenance fee were sent to patentee, but no new instructions were received from patentee.

Counsel further states that upon learning through private PAIR that the patent had expired, counsel "immediately contacted Patentee's representative who maintained that she was confused as to the entity making the actual 12<sup>th</sup> Year Maintenance Fee payment due to the large number of items in her portfolio."

A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include

(1) the required maintenance fee set forth in § 1.20(e) through (g);

(2) the surcharge set forth in § 1.20(I)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The petition lacks item (3).

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".<sup>1</sup> A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."<sup>2</sup> This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>3</sup> Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.<sup>4</sup> Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person

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<sup>1</sup> 35 U.S.C. § 41(c)(1).

<sup>2</sup> Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

<sup>3</sup> Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>4</sup> In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

standard in determining if the delay was unavoidable.<sup>5</sup> However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.<sup>6</sup> In view of In re Patent No. 4,409,763,<sup>7</sup> this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.<sup>8</sup> 35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.<sup>9</sup>

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.<sup>10</sup> That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the second maintenance fee for this patent.<sup>11</sup>

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<sup>5</sup> Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

<sup>6</sup> Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

<sup>7</sup> 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

<sup>8</sup> See Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

<sup>9</sup> See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992); Ray v. Lehman, supra.

<sup>10</sup> Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

<sup>11</sup> Id.

Counsel's contention that the patentee's representative was confused as to who was to make payment of the maintenance fee has been considered, but is not persuasive.

At the outset, petitioner has not provided a statement by Michelle Mariani, the person apparently responsible for timely making the maintenance fee payment, explaining why the entire delay, from the date the maintenance fee was due until the date the payment was made, was unavoidable, setting forth the facts as she knows them. Statements from all other persons, if any, with knowledge of the circumstances surrounding the delay in payment of the maintenance fee are also required. Any documentation supporting petitioner's efforts to timely pay the maintenance fee and why the delay is unavoidable must also be submitted.

The showing of record suggests that rather than unavoidable delay, petitioner was preoccupied with other matters at the time maintenance fee on the present patent were due. Petitioner's preoccupation with other matters which took precedence over timely payment of the maintenance fee in the present patent does not constitute unavoidable delay.<sup>12</sup>

Petitioners has provided no evidence that patentee or patentee's counsel timely proffered payment of the third maintenance fee, or that the delay in payment of the third maintenance fee was unavoidable. Rather, than unavoidable delay, the showing of record is that petitioners failed to take adequate precautions to ensure that the third maintenance fee was timely paid. As petitioners have not shown that they exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.<sup>13</sup>

Lastly, assuming, *arguendo*, patentee believed that counsel would pay the third maintenance fee, the showing, at best, is of a failure of communication between attorney and client. Petitioners are reminded that the failure of communication between an applicant and counsel is not unavoidable delay.<sup>14</sup> Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).<sup>15</sup> Moreover, the Office is not the proper forum for resolving a dispute as to the effectiveness of

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<sup>12</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

<sup>13</sup> See note 2, *supra*.

<sup>14</sup> In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

<sup>15</sup> See Ray v. Lehman, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1995).

communications between parties regarding the responsibility for paying a maintenance fee.<sup>16</sup> Petitioners are reminded that any errors or omissions of petitioners' counsel did not relieve petitioner from its obligation to exercise diligence with respect to this patent.<sup>17</sup> In the absence of an adequate showing of petitioner's diligence in this matter throughout the period in question, the actions or inactions of the registered practitioners will remain imputed to petitioner.<sup>18</sup>

As petitioner has not shown that she exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.<sup>19</sup>

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The \$400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

Any renewed petition must be accompanied by evidence supporting a conclusion that the failure to timely pay the maintenance fee was unavoidable.

#### **ALTERNATIVE VENUE**

Petitioner may wish, in the alternative, to request reconsideration in the form of a petition under 37 CFR 1.378(c), requesting that the unintentionally delayed payment of a maintenance fee be accepted. A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(c) must be filed within twenty four months from the end of the six month grace period (e.g., the expiration date of the patent and be accompanied by (1) a verified statement that the delay was unintentional, (2) payment of the appropriate maintenance fee, unless previously submitted, (3) payment of the \$1,640.00 surcharge (the amount of \$700.00 already paid may be credited thereto leaving a balance due of \$940.00) set forth in 37 CFR 1.20(i)(2). The statement can be verified by using the attached petition form which includes a declaration according to 37 CFR 1.68.

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<sup>16</sup> Id.

<sup>17</sup> Douglas v. Manbeck, 1991 U.S. Dist. LEXIS 16404, 21 USPQ2d 1697, 1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992) (applicant's failure over two and one half year period, to exercise any diligence in prosecuting his application overcame and superseded any omissions on the part of his representative).

<sup>18</sup> See In re Lonardo, 17 USPQ2d 1455 (Comm'r Pat. 1990).

<sup>19</sup> See note 5, supra.

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. *A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the patent was expired until the filing of the petition to reinstate under 37 CFR 1.378(c), was unintentional.* A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.378(c).

Further correspondence with respect to this matter should be addressed as follows:

By mail:            Mail Stop Petition  
                    Commissioner for Patents  
                    P.O. Box 1450  
                    Alexandria, VA 22313-1450

By FAX:            (571) 273-8300  
                    Attn: Office of Petitions

By hand:           Customer Service Window  
                    Mail Stop Petition  
                    Randolph Building  
                    401 Dulany Street  
                    Alexandria, VA 22314

A reply may also be filed via EFS-Web.

Telephone inquiries should be directed to the undersigned at 571-272-3231.



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Office of Petitions

Encl:            Form PTO/SB/66